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## D. REMARKS

### *Specification*

Applicants have amended the specification above to include the application serial numbers and filing dates of the related cross-references and removed references to attorney docket numbers, as requested on page 2 of the Office Action.

### *Interview Summary*

On April 25, 2005 at 8:30 AM EST, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiner Williams. No exhibits were shown, nor demonstrations conducted.

Applicants' representative and the Examiner discussed claim 1. The prior art cited against claim 1 is DeSimone et al. (US Patent 6,212,548) (hereinafter DeSimone) in combination with Smithies et al. (US Patent 6,091,835) (hereinafter Smithies). In particular, Applicants representative requested clarification of the motivation for combining the prior art references under 103(a). Applicants disagreed with the Examiner's assertion that "DeSimone et al., however, does teach the understanding that certain messaging sessions between users may need measures of security provided (Col. 14, lines 50-54)". Applicants requested clarification of how needing security suggests the need for later verifiability of the entries recorded from a messaging session. The Examiner responded that security includes the need for authentication and verification of a messaging session. In addition, Applicants requested clarification of how, when considered as a whole, DeSimone teaches "understanding that certain messaging sessions between users may need measures of security provided" when col. 14, line 55 through col. 15 line 12 indicate that the "particular policies imposed to reflect the nature of conversations and participants" in col. 14 lines 50-54 teach that these policies are for determining which users to admit to a messaging session. The Examiner responded that the nature of the conversation determines the policies needed for security. Applicants' representative continued to disagree with the scope of the Examiner's interpretation of DeSimone and that this interpretation provides the motivation for modifying DeSimone in view of Smithies. In conclusion, no agreement with

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respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

*35 USC § 103(a)*

**1. Claims 1-5, 7-9, 11-13, 15-17, 19-21, 23-25, and 27-38 are not obvious under the combination of DeSimone and Smithies**

Claims 1-5, 7-9, 11-13, 15-17, 19-21, 23-25, and 27-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over DeSimone (US Patent Number 6,212,548) in view of Smithies (US Patent Number 6,091,835). The rejection is respectfully traversed. In particular, the Examiner carries the burden of proving a *prima facie* case of obviousness for a 103(a) rejection. Because the Examiner does not carry the burden of proving a *prima facie* case of obviousness for claims 1-5, 7-9, 11-13, 15-17, 19-21, 23-25, and 27-38, the rejection should be withdrawn and the claims should be allowed.

Claims 1, 11, and 19

With regards to claims 1, 11, and 19, independent method claim 1, which is representative of independent system claim 11 and independent computer program product claim 19, with regard to similarly recited subject matter and rejection, reads as follows:

**1. (Original) A method for recording a verifiable messaging session, said method comprising the steps of:**

recording a selection of message entries from a messaging session, wherein a plurality of users are participating in said messaging session; and attaching a plurality of digital signatures each separately associated with one from among said plurality of users to said recording of said selection of message entries from said messaging session, such that the messaging session is verifiable.

In the rejection of claim 1, the Examiner states the following grounds:

Regarding claim 1, DeSimone et al. discloses a method for enabling a messaging session comprising a plurality of users participating in the session. The participating users are able to view the history of the messaging session in the form of a 'conversation', a string of recorded messaging (Col. 1, lines 48-56; Col. 3, lines 43-53). DeSimone et al. does not disclose that the messaging session is verifiable by attaching digital signatures of the participants to the recording of the

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session. DeSimone et al., however, does teach the understanding that certain messaging sessions between users may need measures of security provided (Col. 14, lines 50-54).

Smithies et al. discloses a method for recording a verifiable transcript of statements, transactions, or events between parties by attaching digital signatures of the participants to the transcript (Col. 3, lines 40-61; col. 41, lines 21-36).

To combine the method for enabling a messaging session and a history of the session between participants with a method for recording digital signatures of participants along with the transcript would provide a needed measure of security. Therefore, it would have been obvious to one ordinarily skilled in the art to combine the method of DeSimone et al. with the method of Smithies et al., because it is obvious that certain messaging sessions between users will require the level of verifiability and accountability that a digitally signed transcript would provide. [Office Action, page 3]

The rejections of claims 11 and 19 incorporate the grounds of rejection of claim 1 into the system and program product taught in claims 11 and 19, respectively. [Office Action, pp. 6-7, 9]

**There is no suggestion or motivation to modify DeSimone by Smithies**

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify the references. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). In particular, the teaching, suggestion or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). In addition, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*,

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713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Applicants respectfully note that the Examiner does not show, nor does DeSimone teach, a suggestion or motivation to modify DeSimone by Smithies to teach the claimed invention as a whole and in particular attaching a plurality of digital signatures each separately associated with one from among said plurality of users to said recording of said selection of message entries from said messaging session, such that the messaging session is verifiable.

First, there is not a suggestion or motivation to modify DeSimone in view of Smithies because when DeSimone is viewed as a whole, DeSimone only suggests that policies control which users can be added as new participants to a conversation, and not that “messaging session between users may need measures of security provided”. The Examiner asserts that col. 14, lines 50-54 of DeSimone teaches “the understanding that certain messaging sessions between users may need measures of security provided”. [Office Action, p. 3] Col. 14, lines 41-54 read:

In other particular embodiments, additional conditions or controls on adding new participants are readily effected. For example, in a client-server messaging handling system, an augmented message can be tested against a list of authorized augments, including, in some cases, only the conversation initiator. When a submitted augmenting message is received at a server and found not to be originated by an authorized augmentor-participant, the proposed augmenting is refused; the newly proposed addition to the participant list is rejected. Other particular policies can be imposed to reflect the nature of the conversations and participants. For example, additions to purely social chat contexts can be considerably relaxed as compared with conversations involving a need for privacy and secrecy.

When lines 50-54 of col. 14 are read within the context of the paragraph in which they are incorporated (lines 41-54 of col. 14), lines 50-54 merely disclose that different policies can be applied for controlling “adding new participants”. Col. 14, lines 41-54 describes that these “policies” for controlling the addition of new participants to a conversation can be determined based on the “list of authorized augments” or based on the “nature of the conversations and participants”. As examples of the policies for controlling the addition of a new participant to a conversation based on the “nature of the conversations”, “purely social chat contexts” are compared with “conversations involving a need for privacy and secrecy.” Therefore, Applicants

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respectfully assert that when DeSimone is viewed as a whole, DeSimone merely teaches that policies can control which users are allowed to be added as participants to a conversation, and does not teach the Examiner's assertion of "the understanding that certain messaging sessions between users may need measures of security provided."

Second, there is not a suggestion or motivation to modify DeSimone in view of Smithies because even if DeSimone teaches "the understanding that certain messaging sessions between users may need measures of security provided", as asserted by the Examiner, DeSimone only teaches applying security to limit those users who can add to a conversation, which does not suggest or motivate modifying DeSimone to teach attaching digital signatures to a recording of a messaging session so that the participants in the messaging session are verifiable. Applicants note that DeSimone's disclosure of placing "conditions or controls on adding new participants" (DeSimone, col. 14, lines 41-42) focuses on blocking entry into a conversation, which is in real time (DeSimone, col. 2, line 53). Thus any "security" disclosed in DeSimone is one of blocking entry into a real time conversation. This "security" of blocking entry into a real time conversation does not teach or suggest a modification to attach digital signatures to a recording of that conversation for later verifiability.

In conclusion, for the foregoing reasons, Applicants respectfully assert that *prima facie* obviousness is not established for claims 1, 11, and 19 because there is no suggestion or motivation to modify DeSimone in view of Smithies under 35 U.S.C. §103(a). Because a *prima facie* case of obviousness is not established, Applicants respectfully request that Examiner reverse the rejection of claims 1, 11, and 19 and allow the claims.

**There is No Reasonable Expectation of Success in the Proposed Modification of DeSimone in view of Smithies**

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed modification of DeSimone in view of Smithies. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Applicants respectfully assert that there is no reasonable expectation of success in the proposed modification of DeSimone by Smithies. Claim 1 teaches a method for recording selected entries of a messaging session and

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attaching digital signatures of the participants of the messaging session to the recording to provide verifiability for the messaging session. DeSimone discloses that different policies may block the addition of participants to a current conversation. *DeSimone*, Col. 14, lines 41-54. Smithies discloses “recording a detailed record or “transcript” of the acts, events or forensic circumstances related to a party’s affirmation of an electronic document, transaction, or event”. *Smithies*, abstract. The Examiner states that the combination of the references would modify DeSimone by Smithies, where the Examiner cites DeSimone as teaching “the understanding that certain messaging sessions between users may need measures of security provided”. [Office Action, p. 3] Applicants respectfully note, however, that even if DeSimone discloses that messaging sessions “may need measures of security provided” the basis of this assertion by the Examiner is a teaching of blocking new participants from joining certain messaging sessions. Col. 14, lines 41-54. DeSimone focuses on securing entry into a messaging session, not recording and attaching digital signatures to the log of the entries of a messaging session. Thus, there is no reasonable expectation of success in the proposed modification of DeSimone by Smithies because any modification would merely adjust the blocking policies of DeSimone by the affirmation transcript of Smithies. Thus, there is no reasonable expectation of success in the proposed modification of DeSimone in view of Smithies and therefore no prima facie case of obviousness as to claim 1. Therefore, because there is no prima facie case of obviousness as to claim 1, Applicants respectfully request allowance of claims 1, 11, and 19.

Claims 2-5, 7-9, 12-13, 15-17, 20-21, and 23-25

In addition, because prima facie obviousness is not established for claims 1, 11, and 19, at least by virtue of their dependency on claims 1, 11, and 19, dependent claims 2-5, 7-9, 12-13, 15-17, 20-21, and 23-25 are not obvious in view of DeSimone and Smithies, alone or in combination, under 35 U.S.C. §103(a). Because a prima facie case of obviousness is not established for claims 2-5, 7-9, 12-13, 15-17, 20-21, and 23-25, Applicants respectfully request allowance of claims 2-5, 7-9, 12-13, 15-17, 20-21, and 23-25.

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Claims 27, 31, and 35

Independent method claim 27, which is representative of independent system claim 31 and independent computer program product claim 35, with regard to similarly recited subject matter and rejections, reads as follows:

27. **(Currently Amended)** A method for transmitting verifiable message entries in a messaging session, said method comprising the steps of:

attaching a digital signature for a sender of a message entry to said message entry; and

distributing said message entry to a plurality of participants in a chat messaging session, wherein each of said plurality of participants in said chat messaging session are enabled to verify said sender of said message entry with said digital signature [in real-time] while participating in said chat messaging session.

In the rejection of claim 27, the Examiner states the following grounds:

Regarding claim 27, the combination of DeSimone et al. and Smithies et al. discloses a method for attaching a digital signature for a sender of a message entry to the message entry; and distributing the message entry to a plurality of participants in a messaging session, wherein each of the plurality of participants in the messaging session are enabled to verify the message entry with the digital signature in real-time (Smithies et al., col. 13, lines 14-51; col. 12, lines 14-16, 51-54; col. 14, lines 65-col. 15, line 4; col. 41, lines 24-36). As disclosed by Smithies et al., messages created by an individual through a client application are 'affirmed' (i.e. digitally signed) by the individual. They are then added to the transcript, where other participants through their respective client applications can view the transcript of messages, verify signatures of the messages, and add their own messages. [Office Action, pp. 11-12]

The Examiner recites rejections of claims 31 and 35, similar to the rejection of claim 27, on pages 13 and 14-15.

Applicants note that the Examiner cites the combination of DeSimone and Smithies as disclosing the elements of claim 27, but the Examiner does not point to any specific teaching in DeSimone as grounds for the rejection. Applicants traverse the grounds of rejection in view of the references to Smithies cited by the Examiner. In addition, as to the combination of DeSimone and Smithies, Applicants respectfully assert the arguments made with reference to claim 1, as to the lack of motivation or suggestion for the combination of DeSimone and

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Smithies and the lack of reasonable expectation of success in the proposed modification, also apply to claims 27, 31, and 35; as a result *prima facie* obviousness is not proved for claims 27, 31, and 35 and Applications respectfully request allowance of these claims.

**Neither DeSimone nor Smithies, separately or in combination, teaches or suggests all the limitations of claims 27, 31, and 35**

In establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Appellants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, the claimed invention as a whole, and in particular does not teach attaching a digital signature for a sender of a message entry to said message entry and distributing said message entry to a plurality of participants in a chat messaging session, wherein each of said plurality of participants in said chat messaging session are enabled to verify said sender of said message entry with said digital signature while participating in said chat messaging session.

DeSimone in view of Smithies does not teach the elements of claim 27 because Smithies does not teach that “messages created by an individual through a client application are ‘affirmed’ (i.e. digitally signed) by the individual. They are then added to the transcript, where other participants through their respective client applications can view the transcript of messages, verify signatures of the messages, and add their own messages.” [Office Action, pp. 11-12]

Smithies teaches a process for requiring a party who is affirming a document, transaction, or statement, to respond to a sequence of questions, make statements, and provide other input. *Smithies*, col. 13, lines 14-51, col. 14, lines 65-col. 15, line 4; col. 41, lines 24-36. The affirmation and the responses are included in a transcript object. *Smithies*, col. 13, lines 14-51,

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col. 14, lines 65-col. 15, line 4; col. 41, lines 24-36. Col. 12, lines 14-16 disclose that the client application that executes the affirmation process may “also be any application that enables affirming parties to execute transactions across networks such as the Internet.” Where multiple parties affirm a transaction, the transcript object created for each affirmation includes information such as “the order of signing or affirming, the time elapsed between each signing or affirmation, and whether the transaction changed between signings or affirmations.” Col. 41, lines 24-36.

*Smithies* does not teach, however, the assertions made by the Examiner as to its teachings and its teachings do not teach the elements of claim 27. The Examiner incorrectly asserts that the affirmed document or “message” is added to the transcript, where other participants can view the transcript of messages, verify signatures of the messages, and add their own messages. In particular, *Smithies* teaches that documents are affirmed by an individual and that the responses during the affirmation process are stored in a transcript object; the document or “message” is not stored in the transcript. *Smithies*, col. 13, lines 14-51, col. 14, lines 65-col. 15, line 4; col. 41, lines 24-36. Where multiple individuals affirm a document, a separate transcript object is created for each affirmation; individuals do not open an affirmation transcript (transcript object) and add their own documents or “messages” to that transcript object. Further, while the client application in col. 12, lines 14-16 is described as one that may enable affirming parties to execute transactions across networks, such as the Internet”, the mere disclosure that the client application is enabling transactions across networks does not lead to a teaching that the transcript object is viewable by other participants in a messaging session or that it is distributed to other participants in a messaging session. In contrast, when considered as a whole, claim 27 teaches that a digital signature is attached to a message entry that is then distributed, within a real time chat messaging session, to each of the participants so that each participant can verify the sender of the message entry while the chat messaging session is ongoing. In particular, Applicants amend claims 27, 31, and 35 to clarify that a message entry is part of a chat, or real time, messaging session and that the sender is verified from the digital signature.

In conclusion, a *prima facie* case of obviousness under 103(a) is not established for claims 27, 31, and 35 because at least one element of claims 27, 31, and 35 is not taught by

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DeSimone and Smithies, separately or in combination. Because a prima facie case of obviousness under 103(a) is not established for the claims 27, 31, and 35, Appellants respectfully request allowance of claims 27, 31, and 35.

**Claims 28-30, 32-34, and 36-38**

In addition, because prima facie obviousness is not established for claims 27, 31, and 35, at least by virtue of their dependency on claims 27, 31, and 35, dependent claims 28-30, 32-34, and 36-38 are not obvious in view of DeSimone and Smithies, alone or in combination, under 35 U.S.C. §103(a). Because a prima facie case of obviousness is not established for claims 28-30, 32-34, and 36-38, Applicants respectfully request allowance of claims 28-30, 32-34, and 36-38.

**2. Claims 6, 10, 14, 18, 22, and 26 are not obvious under the combination of DeSimone, Smithies, and Scheider.**

Claims 6, 10, 14, 18, 22, and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over DeSimone in view of Smithies as applied to claims 1, 9, 11, 17, 19, and 25 above, and further in view of Schneider, Applied Cryptography. [Office Action, p. 16] Application respectfully assert that because prima facie obviousness is not established for claims 1, 11, and 19 under the combination of DeSimone and Smithies, at least by virtue of their dependency on claims 1, 11, and 19, claims 6, 10, 14, 18, 22, and 26 are not obvious under the combination of DeSimone and Smithies and Applied Cryptography under 35 U.S.C. §103(a). Because a prima facie case of obviousness is not established for claims 6, 10, 14, 18, 22, and 26, Applicants respectfully request allowance of claims 6, 10, 14, 18, 22, and 26.

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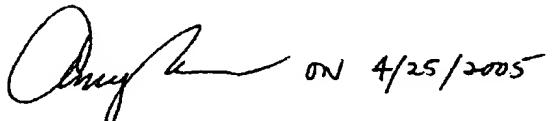
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*Conclusion*

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,

 on 4/25/2005

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